

Remarks

The present response is to the Office Action mailed in the above-referenced case on May 13, 2008. Claims 40-69 are standing for examination.

Claim Rejections - 35 USC § 101

The examiner states:

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material per se.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Dichr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "(the sole practical application of the algorithm was in connection with the programming of a general purpose computer.)").

Claims 40-53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The invention of these claims can be done by software application according to the specification paragraph 0026. Accordingly,

software application is non-statutory subject matter, therefore the claims as whole are found to be directed to a non-statutory subject matter.

Applicant's response:

The examiner states that the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material per se. The examiner further states that the invention of these claims can be done by software application according to applicant's paragraph 26.

But the examiner also states "When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Applicant urges that the examiner cannot have it both ways.

Applicant is claiming a system operable on a computer having software (functional descriptive material) stored on and executable from a data repository (recorded on a computer-readable medium). This language is perfectly within the meaning of *In re Lowry*, and the office and the examiner are severely overstepping the bounds of reason and fact in the over-reaching rejections of claims under Section 101. This new interpretation and practice is attempting to change the law, which is not in the province of the USPTO. If it helps the examiner, we are happy to change the language of "data repository" to "computer-readable medium", which is done by amendment above. Applicant is quite sure, however, that a person of ordinary skill in the art is going to understand that a data repository associated with a computer appliance can be none other than a computer-readable medium.

Claim Rejections - 35 USC § 103

The examiner states:

Regarding claim 40, Shtivelman discloses substantially the invention as claimed a communication management system, comprising: a computer appliance (see abstract, figure 1 details; system is using computer appliances); software stored on and executable from a data repository accessible by the computer appliance (see abstract; col. 2, lines 27-43; data repository storing parameters and a management software executes on a server associated with the communication center system), the software providing:

one or more activity-specific zones (see col. 1, lines 45-56; rules and regulations regarding sessions); a user identity associated with each of the zones; and a set of contact identities associated with each of the zones;

wherein policy determined in part by associated user and contact identities is enforced in managing communication from and to each zone (see col. 1, lines 28-35, col. 2, lines 44-57).

Shtivelman substantially discloses the invention as claimed for the given reason above however does not explicitly disclose wherein said a user identity associated with each of the zones. However in the same field of invention Matsui discloses wherein said a user identity associated with each of the zones (see figure 1, col. 8, lines 41-59; area identifiers each for mutually discriminating a plurality of communication areas).

It would have been obvious to one of the ordinary skill in the art of networking at the time of this invention to combine the teaching of Shtivelman and Matsui for a communication management system. Motivation for doing so would have been this system is advantageous for a communication management apparatus for managing a joining of symbols in a virtual world in a message communication system in which a plurality of user terminals are interconnected, the plurality of user terminals sharing the virtual world comprising a plurality of virtual spaces, and the symbols each defined for the associated one of the user terminals which will join the virtual world, and messages are exchanged among a plurality of user terminals corresponding to a plurality of symbols which have entered the same virtual space (see Matsui: col. 1, lines 7-14).

Regarding claim 41, the combination of Shtivelman and Matsui disclose wherein Matsui further discloses the system of claim 40 wherein the user identity refers to a single user, but may vary from zone to zone as an alias (see Figure 1, col. 8, lines 41-59).

Regarding claim 42, Shtivelman discloses the system of claim 40 wherein the communication involves transmission over the Internet network (see figure 1 (13); Internet).

Regarding claim 43, the combination of Shtivelman and Matsui disclose wherein Matsui further discloses the system of claim 40 wherein the contact identifies include one or more identities of persons accessible on a communication network (see col. 16, lines 9-25).

Regarding claim 44, the combination of Shtivelman and Matsui disclose wherein Matsui further discloses the system of claim 43 wherein individual ones of the contact identifies may be aliases referring to a single contact (see figure 1, col. 8, lines 41-59).

Regarding claim 45, Shtivelman discloses the system of claim 40 wherein individual ones of the zones are defined by various social environments engaged in by the user (see col. 1, lines 57-67, col. 2, lines 1-2).

Regarding claim 46, Shtivelman discloses the system of claim 42 wherein communication is supported in multiple modes and protocols, including but not limited to voice and text modes (see col. 1, lines 17-27).

Regarding claim 47, the combination of Shtivelman and Matsui disclose wherein Matsui further discloses the system of claim 46 wherein contact identity sets vary by communication mode as well as by zone (see figure 1, col. 8, lines 41-59).

Regarding claim 48, Shtivelman discloses the system of claim 46 wherein the multiple modes include email, instant messaging, RSS, and voice mode (see col. 1, lines 17-27).

Regarding claim 49, the combination of Shtivelman and Matsui disclose the system of claim 40 wherein pairing of user with contact identity is used in determining and enforcing communication policy (see Shtivelman: col. 1, lines 28-35, col. 2, lines 44-57; Matsui: col. 8, lines 41-59).

Regarding claim 50, Shtivelman discloses the system of claim 40 further comprising generating alerts from attempted policy violation (see col. 7, lines 37-45).

Regarding claim 51, Shtivelman discloses the system of claim 40 wherein a user identity may be in a form of a URL, an email address, a telephone number, a machine address, an IP address, or an Enum address (see col. 1, lines 17-27, col. 5, lines 32-42).

Regarding claim 52, the combination of Shtivelman and Matsui disclose the system of claim 40 wherein policy includes protocol for automatic handling of incoming communication events, the handling determined by one or both of contact identity of sender and mode of communication (see Shtivelman: figure 3, col. 1, lines 28-35, col. 2, lines 44-57; Matsui: col. 8, lines 41-59).

Regarding claim 53, the combination of Shtivelman and Matsui disclose wherein Matsui further discloses the system of claim 40 further comprising an editing facility for a user to create and populate zones, identities and policy (see col. 8, lines 41-59,)

Regarding claim 54, Shtivelman discloses substantially the invention as claimed a method for managing communication, comprising steps of:

(a) at a communication interface provided by software executing from a data repository of a computer appliance, prior to sending an outgoing message from, or routing an incoming message to one of a set of activity-specific zones, considering user and contact identifies associated with the zone (see figure 1; col. 1, ;lines 17-27, incoming and outgoing communications; col. 2, lines 27-43; data repository storing parameters and a management software executes on a server associated with the communication center system and col. 1, lines 45-56; rules and regulations regarding sessions); and

(b) enforcing policy in the sending or routing determined at least in part by user identity and contact identities associated with the zone (see col. 1, lines 28-35, col. 2, lines 44-57).

Shtivelman substantially discloses the invention as claimed for the given reason above however does not explicitly disclose wherein said contact identity associated with the zone. However in the same field of invention Matsui discloses wherein said contact

identity associated with the zone (see figure 1, col. 8, lines 41-59; area identifiers each for mutually discriminating a plurality of communication areas).

It would have been obvious to one of the ordinary skill in the art of networking at the time of this invention to combine the teaching of Shtivelman and Matsui for a communication management system. Motivation for doing so would have been this system is advantageous for a communication management apparatus for managing a joining of symbols in a virtual world in a message communication system in which a plurality of user terminals are interconnected, the plurality of user terminals sharing the virtual world comprising a plurality of virtual spaces, and the symbols each defined for the associated one of the user terminals which will join the virtual world, and messages are exchanged among a plurality of user terminals corresponding to a plurality of symbols which have entered the same virtual space (see Matsui: col. 1, lines 7-14).

Regarding claim 55, Shtivelman discloses the method of claim 54 further comprising a step for content analysis of message and/or attachment for identification and verification of a contact (see col. 7, lines 8-20).

Regarding claim 56, the limitations of this claim has already been addressed (see claim 41 above).

Regarding claim 57, the limitations of this claim has already been addressed (see claim 42 above).

Regarding claim 58, the combination of Shtivelman and Matsui disclose the method of claim 54 wherein the contact identities include one or more user identities of other users also using an instance of the software on a different computer appliance (see Shtivelman: figure 1, col. 27-44 and Matsui: col. 8, lines 41-59)

Regarding claim 59, the limitations of this claim has already been addressed (see claim 44 above).

Regarding claim 60, the limitations of this claim has already been addressed (see claim 45 above).

Regarding claim 61, the limitations of this claim has already been addressed (see claim 46 above).

Regarding claim 62, the limitations of this claim has already been addressed (see claim 47 above).

Regarding claim 63, the limitations of this claim has already been addressed (see claim 48 above).

Regarding claim 64, the limitations of this claim has already been addressed (see claim 49 above).

Regarding claim 65, the limitations of this claim has already been addressed (see claim 50 above).

Regarding claim 66, the limitations of this claim has already been addressed (see claim 51 above).

Regarding claim 67, the limitations of this claim has already been addressed (see claim 52 above).

Regarding claim 68, the limitations of this claim has already been addressed (see claim 53 above).

Regarding claim 69, combination of Shtivelman and Matsui disclose wherein Matsui further discloses the method of claim 68 wherein some of the user identities may be temporary ad hoc identifies (see figure 1, col. 8, lines 41-59).

Applicant's response:

Regarding claim 40, applicant has herein amended the claim to recite, as amended:

40. (Currently amended) A communication management system, comprising:

a computer appliance;

software stored on and executable from a computer-readable medium accessible by the computer appliance, the software providing:

a choice of a plurality of communication-management zones, each zone having associated therewith a unique set of users, each user identified by a unique name in the zone, and one or more management policies associated with each zone, each user

associated with a management policy;

wherein the system activates a zone based at least on names of active users, and enforces a management policy as long as the zone is active.

The examiner continues to use Shtivelman, and the teaching of a chat room as reading on limitations of claim 40, saying that "Regarding claim 40, Shtivelman discloses substantially the invention as claimed a communication management system, comprising: a computer appliance (see abstract, figure 1 details; system is using computer appliances); software stored on and executable from a data repository accessible by the computer appliance (see abstract; col. 2, lines 27-43; data repository storing parameters and a management software executes on a server associated with the communication center system), the software providing:

one or more activity-specific zones (see col. 1, lines 45-56; rules and regulations regarding sessions); a user identity associated with each of the zones; and a set of contact identities associated with each of the zones;

wherein policy determined in part by associated user and contact identities is enforced in managing communication from and to each zone (see col. 1, lines 28-35, col. 2, lines 44-57).

The applicant urges that col. 1, lines 45-56 describe generically the operation of a chat room, wherein a single agent may communicate with more than one client at a time. Ability is taught that an agent may mute participants or eliminate participants, and enforce rules and regulations. There is, however, no teaching at all regarding a plurality of different, selectable zones, as claimed, nor a unique set of users associated with each of the different zones. These limitations are simply not there, and would not be imagined by a skilled artisan familiar with the operation of a chat room. Regulations regarding a session cannot be stretched to read on activity-specific zones associated each with a set of users.

Further to the above, there is no teaching re: Shtivelman for a chat room software

enforcing policy (the live agent enforces policy) or for a chat room activating one of a choice of several zones, as now claimed, based at least on names of active users, or enforcing a management policy as long as the zone is active.

The functionality of a chat room did not read on claim 40 unamended, and certainly does not read on claim 40 as currently amended. The selection of a zone by the system based on active users, and enforcement of policy as long as a zone is active is not functionality of a chat room. In a chat room the policy is set before users enter the chat, and the presence of a set of users does NOT change the chat room or the policy.

Continued use of Shtivelman alleging to read on the limitations of claim 40 is inappropriate, and Shtivelman should be withdrawn.

Claim 40 as amended herein is patentable over the combination of Shtivelman and Matsui at least by virtue of the system selecting a zone based on associated users, and by enforcing policy as long as a selected zone is active. Therefore claims 41 through 53 are patentable at least as depended from a patentable claim.

Claim 54 is a method claim with essentially the limitations of claim 40, and is patentable by the same facts and reasons stated above on behalf of claim 40; therefore claims 55-69 are patentable at least as depended from a patentable claim.

Summary

As all of the claims as listed above, including any current amendments, have been shown to be patentable over the art cited and applied, the applicant respectfully requests reconsideration, and that the case be allowed and passed quickly to issue.

If there are any time extensions needed beyond any extension specifically requested with this amendment, such extension of time is hereby requested. If there are any fees due beyond any fees paid with this amendment, authorization is given to deduct such fees from deposit account 50-0534.

Respectfully Submitted,
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